REMARKS

As a result of amendment, claims 1-20 and 22-28 are now pending in this application. Of these, claims 21-28 stand rejected under §101; claims 1-20 and 28 stand rejected under §112; claims 21 and 22 stand rejected under §102; and claims 23-25 stand rejected under §103.

A detailed response to the rejections follows. However, applicant reserves all applicable rights not exercised in connection with this response, including, for example, the right to swear behind one or more of the cited references, the right to rebut any tacit or explicit characterization of the references, and the right to rebut any asserted motivation for combination. Applicant makes no admission regarding the prior art status of the cited references, regarding them only as being of record in the application.

Response to §101 Rejections

Claims 21-28 were rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. In response, applicant submits respectfully that claim 21 has been canceled, and that claims 25 and 28 have been amended respectively to recite "a machine-implemented method" and a "an automated method." Moreover, applicant submits that these and their dependents recite a methodology that yields at least one useful, concrete and tangible result in the form of at least one or more scores.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §101 rejections.

Response to §112 Rejections

The Examiner rejected claims 1-20 under 35 USC §112, first paragraph, as not providing sufficient support for the claimed "class-specific weight."

In response, application submits respectfully that, at page 6, lines 26-31, applicant teaches:

> ALR annotation database 110 (more generally a database of electronic documents classified according to a target classification scheme) includes a set of 13,779 annotations, which are presented generally by annotation 112. **The exemplary embodiment regards each annotation as a class or category.** Each annotation, such as annotation 112, includes a set of one or more case citations, such as citations 112.1 and 112.2. (Emphasis Added.)

Further, applicant teaches at page 16, lines 13-23 (as amended):

> Block 235, which represents operation of composite-score generator 135, entails computing a set of composite similarity scores CS_a^h based on the sets of similarity scores determined at blocks 231-235 by classifiers 131-135, with each composite score indicating the similarity of the input headnote h to each annotation a. More particularly, generator 135 computes each composite score CS_a^h according to

$$CS_a^h = \sum_{i=1}^{4} w_{ia} S_{a,i}^h, \qquad (19)$$

> where $S_{a,i}^h$ denotes the similarity score of the i-th similarity score generator for the input headnote h and annotation a, and w_{ia} is a weight assigned to the i-th similarity score generator and annotation a. Thus, w_{ia} is a weight specific to the i-th similarity score generator and to annotation (or class) a. Execution of the exemplary method then continues at block 236. (As amended; no new matter added.)

Also, at page 17, lines 12-25, applicant teaches an exemplary method for determining optimal weights.

In view of the exemplary support found in these cited passages, applicant requests respectfully that the Examiner reconsider and withdraw the §112-first-paragraph rejection.

The Examiner rejected claims 1-20 and 28 under 35 USC §112, second paragraph as indefinite, specifically questioning antecedence of "the [target] class" in claim 1 and the relation of one score to four scores in claim 28.

In response, applicant submits respectfully that "the target class" at line 10 of claim 1 finds antecedence at "each target class" in line 3. Accordingly, applicant requests that the Examiner reconsider and withdraw the indefiniteness rejection of claim 1 and its dependents.

Applicant also submits that its representative reviewed claim 28, and did not find a recitation related to four scores. Thus, further clarification of asserted indefiniteness of this claim is requested.

Response to §102 Rejections

Claims 21 and 22 were rejected under 35 USC §102(b) as being anticipated by Zernik (U.S. 5,383,120).

In response, applicant submits respectfully that this amendment cancels claim 21 without prejudice or disclaimer, and amends claim 22 to depend on claim 25. As such, the §102 rejections are believed to be moot.

Response to §103 Rejections

Claims 23-25 were rejected under 35 USC § 103(a) as unpatentable over Zernik in view of Wiltshire (U.S. 6,502,081).

In response, applicant submits respectfully that claims 23 and 24 have been amended to depend on claim 25, which has been rewritten in independent form. Further, applicant submits that even if the proposed combination of Zernik and Wiltshire were permissible, claim 25 appears to distinguish. Specifically, claim 25 recites "determining one or more scores based on frequencies of ... one or more noun-word pairs in text associated with one of the target classes."

Wiltshire does not appear to teach this feature. Instead, Wiltshire reports, at column 5, lines 54-64: "This step defines the relevance of features using frequency of the features, both within each [extracted] legal concept and across the entire set of training legal concepts. These two frequencies--within a legal concept and across the entire set--are combined to give a relevance score for each feature, for each legal concept. These legal concept relevance scores are then used to identify the most relevant topics for the candidate concept, during the classification process." See also, column 8, lines 20-65. Notably, Wiltshire seeks to classify legal concept to a topic (or class). There is no indication that noun-word frequencies are determined for a given topic or class.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejections.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111   Page 13
Serial Number: 10/027,914   Dkt: 962.015US1
Filing Date: December 21, 2001
Title: SYSTEMS, METHODS, AND SOFTWARE FOR CLASSIFYING TEXT FROM JUDICIAL OPINIONS AND OTHER DOCUMENTS

CONCLUSION

In view of the foregoing remarks and the amended claims, applicant requests respectfully that the Examiner reconsider and withdraw the rejections. Further, applicant invites the Examiner to telephone its patent counsel Eduardo Drake at (612) 349-9593 to resolve any remaining issues which might delay allowance. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KHALID AL-KOFAHI ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9593

Date _20 Dec. 2004_

By _____
Eduardo E. Drake
Reg. No. 40,894

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this _20_ day of December, 2004.

KACIA LEE

Name

Kacia Lee

Signature